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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,341	12/31/2001	C. Douglass Thomas	CDTP006D1	3476
7590 C. Douglass Thomas 1193 Capri Drive Campbell, CA 95008			EXAMINER AL HASHEMI, SANA A	
			ART UNIT 2164	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/039,341

Applicant(s)

THOMAS, C. DOUGLASS

Examiner

Sana Al-Hashemi

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26-31-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is issued in response to amendment filed 1/17/08

Claims 1, 2, 6, 13, 18-20, 31, were amended. Claims 28-30 were canceled. Claims 34-37 were added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 32-37 rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider US Patent No. 6,338,082 in view of Balijepalli et al. (Balijepalli hereinafter) US Pre-Grant publication No. 2004/0230566.

Claims 1 and 13: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a "WHOIS" database. Initiating a search is an act of monitoring. Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67). Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system. Determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored (Col. 5, lines 5-16, Scheinder);

Schneider differs in that the search step is not recited as being performed periodically and automatically. However, Balijepalli et al. teaches the concept of periodically and automatically performing a search for data on a network (paragraph 0008, last two lines) in order to return the most relevant and recent information to the user (paragraph 0004, last three lines). The periodic searching produces periodic results (paragraph 0005, first four lines). It would have been obvious to one of ordinary skill in the art to modify Schneider to perform periodic automatic searches and automatically deliver the results to the user in order to provide the most relevant and current information, as taught by Balijepalli et al.

Claim 2: URLs associated with domain names can be communicated via electronic mail (col. 5, line 38).

Claim 3: The monitored name is a domain name (FIG. 3A, step 306).

Claim 4: A "WHOIS" database is a registry of domain names, and a plurality of such registries exist throughout the world (col. 5, lines 15-24).

Claim 5: Col. 5, lines 40-44 illustrate a domain name as a string of characters ("example.com").

Claim 6: FIG. 3A, step 306 establishes that a search is performed for a domain name. Col. 5, lines 40-44 establish that a domain name is a string of characters ("example. com"). Accordingly, the search for the domain name involves a search for a string of characters.

Claim 7: The search of the WHOIS database registries involves searching all entries for matches. Such a search would inherently involve relatively more recent entries and relatively older entries.

Claim 8: FIG. 3A illustrates the generation of a notification message (display record). The display record is displayed to the user who initiated the request, thus the message is forwarded to the requestor.

Claim 9: The WHOIS database inherently contains data on domain name registrant, contact information, and date of registration or update to registration. Examiner has provided a copy of a WHOIS search for "Washington College" as evidence to support this conclusion, although the search results are not being referred to as prior art, since examiner maintains that the claimed features are inherent, rather than obvious.

Claim 10: FIG. 3A, step (306) illustrates receiving a request from a requestor. The request can be made over the Internet using a TCP/IP application (col. 5, lines 5-15).

Claim 32: Col. 6, lines 60-64 provide an example of where a template search term is used where the template search term includes both text and the wildcard character "%". Schneider differs in that the search step is not recited as being performed periodically and automatically. However, Balijepalli et al. teaches the concept of periodically and automatically performing a search for data on a network (paragraph 0008, last two lines) in order to return the most relevant and recent information to the user (paragraph 0004, last three lines). The periodic searching produces periodic results (paragraph 0005, first four lines). It would have been obvious to one of ordinary skill in the art to modify Schneider to perform periodic automatic searches and automatically deliver the results to the user in order to provide the most relevant and current information, as taught by Balijepalli et al.

Claims 34 and 37: Schneider Fig. 2b, step 230 showing the error message which corresponds to the warning message to at least one register of the identified one or more registration.

Claim 35: Schneider Fig. 3a, discloses the monitoring activation of a website at the domain names to the identified one or more registrations.

Claim 36: Schneider Fig. 3a step 314 discloses the step of informing the requestor of the activation of a website at the domain name of the identified one or more registrations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-12, 31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider (U.S. Patent 6,338,082).

Claim 11: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a "WHOIS" database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system.

The displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.

Claim 12: The display of search results from the WHOIS search (step 318) is automated (done

without manually searching through all the record). Accordingly, the action of sending a message (displayed results) is done automatically.

Claim 31: The input of the requested name is provided through the Internet (FIG. 1A). Claim 33: Reference is made to FIG. 3A and its associated discussion at col. 12, line 57 through col. 13, line 25. Step 306 in FIG. 3A is the receipt of request to monitor a name by initiating a search in a "WHOIS" database. Initiating a search is an act of monitoring.

Step (314) diagrammatically illustrates the search for the domain name in the WHOIS database and the determination as to the existence of the name (also see col. 12, lines 62-67).

Step (318) illustrates the return to the requestor of a displayed record of a domain name when such domain name is identified in the WHOIS database system.

Response to Arguments

Applicant's arguments filed 10/18/07 have been fully considered but they are not persuasive.

It is a well settled rule that a reference must be considered not only for what it expressly teaches but also for what it fairly suggests. See *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) and *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976) as well as *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977) which indicates such fair suggestions to unpreferred embodiments must be considered even if they were not illustrated. Additionally, it is an equally well settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts. See *In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956).

Applicant argues the rejection fails to establish a prima facie case of obviousness. Three basic criteria must be met. First there must be some suggestion or motivation. Second, there must be a reasonable expectation of success.

Examiner disagrees. A prima facie case was established. First the rejection above on page 3 stated the motivation to combine the 2 references and the expectation of success.

Applicant argues the combination of Schneider in view of Balijepalli do not teach or suggest all the claim limitations.

Examiner disagrees. As stated in the rejection above all the limitations have been addressed.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is 571-272-4013. The examiner can normally be reached on 8Am-4:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sana Al-Hashemi/
Primary Examiner, Art Unit 2164